

#### IV. REMARKS

1. Claims 10-12 are cancelled without prejudice.
2. Claims 1-3 and 6-9 are not unpatentable over Honkasalo et al. ("Honkasalo") in view of Li under 35 U.S.C. §103(a).

Claims 1, 8 and 9 recite using a transmission power on a set level on the radio channel to transfer information and that one of the blocks comprises information on the "transmission power level" of one block of the downlink data transmission or another block of the downlink data transmission to be transmitted subsequently. This is not disclosed or suggested by Honkasalo in view of Li.

In Applicants' invention, the base station transmission power information is attached to the downlink blocks being sent at the same moment or later on. In Honkasalo, information on the quality level of the uplink bursts are attached to the downlink control messages. (Col. 8, lines 11-13). However, this information cannot be contained in the uplink bursts, because unlike Applicants' invention, it is calculated afterwards by the base station based on the reception. (Col. 7, line 61 to col. 8, line 9). Unlike Applicants' invention, the quality level is based on the uplink bursts that are sent earlier by the terminal. Thus, Honkasalo, as is also noted by the Examiner, does not disclose or suggest each feature of Applicants' invention as recited in the claims.

Li does not overcome the deficiencies of Honkasalo. Applicants' invention, as recited in claims 1-3 and 6-9, refers to the "power level" aspects of data transmission. Li does not refer to "power level". All of the passages of Li cited by the Examiner in

support of are directed to "data rate" and not "power level." "Data Rate" and "power level" are two completely different technical aspects of data transmission.

For example, "data rate" is the amount of data transferred per second by a communications channel or a computing or storage device. Data rate is typically measured in units of bits per second (Bps) or baud. When applied to "data rate", the multiplier prefixes "kilo", "mega", or "giga", etc., and their abbreviations, "k", "M", "G", etc., always denote powers of 1000. For example, 64 kbps is 64, 000 bits per second. This contrasts with units of storage where they stand for powers of 1024, e.g. 1 KB= 1024 bytes.

"Power level" on the other hand refers to the "RF power level. The RF power level at either transmitter output or receiver input is typically expressed in "Watts." The RF power level can also be expressed in "dBm." The relationship between "dBm" and "watts" can be expressed as follows:  $P_{dBm} = 10 \times \log P_{mw}$ . For example: 1 Watt = 1000 mW;  $P_{dBm} = 10 \times \log 1000 = 30 \text{ dBm}$ . 100mW;  $P_{dBm} = 10 \times \log 100 = 20 \text{ dBm}$ . For link budget applications, the dBm convention is more convenient than the Watts convention.

In the term "dBm" as referenced above, "dB" is referenced to 1 milliwatt. The term "dBm" is used in a communication network as a measure of absolute power values, where zero dBm equals one milliwatt.

Li does not teach or suggest the use of "power level" as recited by Applicants in the claims, but rather merely deals with "data rate." Thus, Li does not disclose or suggest Applicants' invention as claimed.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the references when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, neither Honkasalo nor Li disclose or suggest each feature of Applicants' invention as claimed, either alone or in combination. Thus, a *prima facie* case of obviousness cannot be established. Therefore, claims 1-3 and 6-9 are patentable over Honkasalo in view of Li.

Furthermore, in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Applicants submit that there is no suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Honkasalo or Li. The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Honkasalo in view of Li under 35 U.S.C. §103(a) cannot be established.

3. The rejection of claims 10-12 over Honkasalo in view of Grubeck should be moot in view of the cancellation of those claims.

4. Claim 4 is not unpatentable over Honkasalo and Li in view of Hamalainen under 35 U.S.C. §103(a). Claim 4 depends from claim 1 and should be allowable at least in view of the dependency, since as noted above, Honkasalo in view of Li does not disclose or suggest Applicants' invention. Furthermore, in Hamalainen, the burst do not have quality level or other information attached to them. Thus, the combination with Hamalainen does not disclose or suggest Applicants' invention.

Furthermore, Applicants respectfully submit that, in accordance with the argument recited in paragraph 2 above, there is no "motivation" to combine the references as required under 35 U.S.C. §103(a).

5. Claim 5 is not unpatentable over Honkasalo, Li and Hamalainen and Turina under 35 U.S.C. §103(a). Claim 5 depends from claim 4 and should be allowable at least in view of the dependency, since as noted above, Honkasalo in view of Li and Hamalainen does not disclose or suggest Applicants' invention. Turina does not overcome the deficiencies of Honkasalo and Li noted above and also does not disclose or suggest that the burst have quality level or other information attached to them. Furthermore, Applicants' respectfully submit that, in accordance with the argument recited in paragraph 2 above, there is no "motivation" to combine the references as required under 35 U.S.C. §103(a).

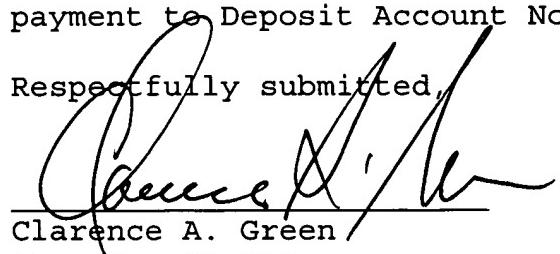
6. Claims 13-16 not unpatentable over Honkasalo and Li in view of Whitehead under 35 U.S.C. §103(a). Claims 13-16 depend from

claim 1, and should be allowable at least in view of the respective dependencies. Whitehead does not overcome the deficiencies noted above. Furthermore, Applicants' respectfully submit that, in accordance with the argument recited in paragraph 2 above, there is no "motivation" to combine the references as required under 35 U.S.C. §103(a).

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
Clarence A. Green

Reg. No. 24,622

  
Date

Perman & Green, LLP  
425 Post Road  
Fairfield, CT 06824  
(203) 259-1800 Ext. 134  
Customer No.: 2512



RECEIVED

SEP 24 2003

Technology Center 2600

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 9/19/03

Signature: D. Boband  
Person Making Deposit